

constructive or actual reduction to practice and (2) only three of the five co-inventors signed the August 27, 2001 37 C.F.R. § 1.131 Declaration submitted to overcome Walker. These rejections are respectfully traversed and are considered in turn.

1. Evidence of Diligence

The Examiner asserts that there is insufficient evidence in the August 27, 2001 § 1.131 Declaration to show due diligence for the period from the summer of 1997 to the summer of 1998. The Examiner's rejection may be respectfully traversed because (1) the Examiner is considering the wrong time period and (2) the August 27, 2001 § 1.131 Declaration contains sufficient evidence of due diligence for the correct time period.

The conception of the present invention occurred before September 4, 1996. August 27, 2001 § 1.131 Declaration, p. 2. Walker was filed on September 4, 1996. The effective prior art date for an U.S. patent is its filing date. 35 U.S.C. § 102(e). The first (actual) reduction to practice of the present invention occurred in July 1997. August 27, 2001 § 1.131 Declaration, p. 5. The Examiner is correct that due diligence must be shown for a period from a date prior to the filing date of Walker to the date of reduction to practice of the present invention. "The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver, but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice." MPEP § 2138.06. Therefore, diligence must be shown from just prior to September 4, 1996 to July 1997. The Examiner incorrectly sets the period between the summer of 1997 and the summer of 1998. The time between reduction to practice and filing of an application is irrelevant to a declaration (claiming diligence) under § 1.131. MPEP § 715.07(a).

Diligence has been demonstrated from just prior to September 4, 1996 to July 1997. See Declaration of Prior Invention of August 27, 2001, e.g. paragraphs 7-14, for the period July 1996 to July 1997.

Further evidence is submitted with this response. See enclosed Third Supplemental Declaration of Prior Invention. Facts corroborating diligence, with supporting documents, are set forth.

Therefore, it is respectfully submitted that competent evidence of diligence has been submitted, and that prior invention is established relative to Walker, such that it should be removed as a reference. It is further submitted that Applicants' claims are allowable over this rejection.

2. *Inventors*

The Examiner also asserts that the August 27, 2001 § 1.131 Declaration is invalid because no evidence of a good faith effort to obtain the signatures of the remaining inventors (John E. Stucki and Alan G. Schmitz) was presented. The Examiner's rejection may be respectfully traversed. Inventors Stucki and Schmitz were no longer employees of the owner of the present application at the time of the August 27, 2001 § 1.131 Declaration. However, in light of the Office Action, inventor John E. Stucki has been located although he declines to participate in patent prosecution. See enclosed First Supplemental Declaration, ¶ 4 and attached Exhibit E.

Where it is shown that a joint inventor refuses to sign, the signatures of the remaining joint inventors are sufficient. MPEP § 715.04. Therefore, the Examiner's argument with respect to joint inventor John E. Stucki is overcome.

Inventor Alan G. Schmitz has been located and he has confirmed the August 27, 2001 § 1.131 Declaration. See Second Supplemental Declaration. Therefore, the Examiner's argument with respect to joint inventor Alan G. Schmitz is overcome.

3. The Teaching of Walker

Applicant also has submitted that regardless of whether Walker is validly cited against Applicants' claims, a *prima facie* case of obviousness has not been made out by based on Walker in view of the secondary references. One ground raised by Applicants is that there is no teaching or suggestion in the cited references to combine those references.

In the final rejection the Examiner admits that Walker does not disclose the Applicants' invention, but argues Walker teaches its invention is applicable to "buyer driven" markets and that the secondary cited reference, the Commodity Trading Manual ("Manuel") is also "buyer driven", and that this suggests there combination. This conclusion is respectively traversed.

Walker is "buyer driven" in the sense it is a system for the exchanges of goods or services. It is essentially a "request for quote" ("RFQ") or "request for proposal" ("RFP") system. Walker's Abstract states:

The present invention is a method and apparatus for effectuating bilateral buyer-driven commerce. The present invention allows prospective buyers of goods and services to communicate a binding purchase offer globally to potential sellers, for sellers conveniently to search for relevant buyer purchase offers, and for sellers potentially to bind a buyer to a contract based on the buyer's purchase offer.

Walker also describes RFP processes and how they are presently in use. See Walker, Col. 2, lines 55-68, and Col. 3, lines 1-27. Buyers post what good or service they desire to purchase in the form of a "conditional purchase offer" ("CPO"). Sellers can review a

CPO and decide whether to accept the CPO. If accepted, the system can generate a contract with details of delivery, etc.

The present invention is distinctly different. It is not an RFQ, RFP or CPO system. There is no request for quote or proposals. Rather, prospective sellers and prospective buyers can look for contracts that meet certain criteria. sent by a buyer for quote of a good or service. The "buyer" here is can look through a number of contracts. The user of Applicant's system could be any one of a number of persons. Examples would be a buyer, a seller, a producer, or a reseller; to name some. Therefore, there can be one "buyer" seeking contracts or obligations with multiple "sellers".

But further, once a contract is selected, Applicants' system manages not only the contract but at least parts of its execution. It manages the information associated with the contract. It manages allocations of availability.

This is not Walker. Nor does Walker suggest this. The secondary references likewise do not suggest this. For example, the "Commodity Trading Manual" describes the state of the art way of commodity trading. It does not suggest use of an RFQ-type procedure. In contrast, it corroborates how commodity trading has different factors, considerations, steps, dynamics, etc. than an RFQ or RFP system. There is no teaching or suggestion in Walker of applying itself the system of Applicants. There is no teaching or suggestion of applying the system of the Manual to a Walker-type RFQ system. Therefore, there is no suggestion of combining such divergent concepts and there is no *prima facie* showing of obviousness.

As the Federal Circuit explained in In re Fitch,

"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or

suggestion supporting the combination. Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. (Emphasis added) In re Fitch 23 USPQ 1780, 1783-84 (Fed. Cir. 1992).

It was further stated by the Federal Circuit in Ex Parte

Levengood that:

" . . . an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence that the motivating force which would impel one skilled in the art to do what the patent applicant has done". Ex Parte Levengood 28 USPQ 1300, 1302 (Fed. Cir. 1993).

As the Board of Patent Appeals and Interferences has stated, "citing references which merely indicate that isolated elements and/or features recited in claims are known is not sufficient bases for concluding that the combination of claimed elements would have been obvious." Ex Parte Hiyamizu, 10 USPQ2d 1393, 1394 (BPAI 19988).

In short, as stated by the Federal Circuit,

"It is wrong to use the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the results of the claims-in-suit."

Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983). "The mere fact that the claimed elements may be found in the prior art is insufficient to support an obviousness rejection under § 103." In re Rouffet, 47 USPQ.2d 1453, 1457 (Fed. Cir. 1998).

C. Rejection Based on Smith in View of Hipsly

Examiner's continued rejection of claim 24 under 35 U.S.C. § 103 as obvious is respectfully traversed for at least the reasons expressed in our prior response. See Response to Office Action, August 27, 2001, particularly pages 4-6, which is incorporated by reference herein.

In addition, in Applicants' prior response, it was specifically pointed out that Applicant's claim 24 explicitly specifies the step of:

"...providing a control script which uses a limited amount of state data stored by the Internet browser during the execution of a task, the state data stored by the browser identifying a subset of master state data stored in the database system..."

As explicitly described in Applicants' specification page 10, lines 20-25, the limited amount of "state data" stored by the Internet browser is used to identify the subset of "master" (or actual) state data. The practical advantage is that complete state data does not need to be maintained and transferred by the Internet browser. This reduces overhead and/or allows increased amounts of state data to be used. This is important in the context of the present invention because it assists in, for example, keeping track of the contracts that are described in Applicants' specification.

Therefore, there is a limited amount of state data stored in the Internet browser to identify the state data stored in the database. But it is further pointed out that Applicants' claim 24 includes the following step:

"...preventing the state data stored by the browser to be entered into database system and updating the subset of master data when the task is aborted by the user."

The advantage of this is explained in Applicants' specification. *See, e.g.*, pages 10-11.

The claim specifically includes the step of storing the limited amount of state data on the

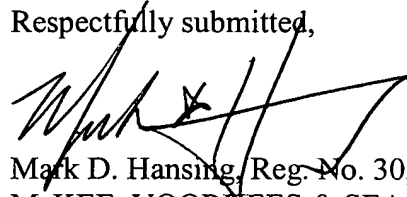
browser side with the server database and updating when a task is aborted. There is no disclosure, teaching or suggestion of this by Smith or any reference cited in the Office Action. It is respectfully submitted Claim 24 is allowable over the cited art.

D. Conclusion

It is respectfully submitted that claims 1-28 are in form for allowance.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



Mark D. Hansing, Reg. No. 30,643
McKEE, VOORHEES & SEASE
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No. (515) 288-3667
Fax No. (515) 288-1338
CUSTOMER NO: 22885

MDH/alt

Enclosures: First Supplemental Declaration (w/ attached Ex. E)
Second Supplemental Declaration
Third Supplemental Declaration (w/ attached Exs. F-L)